



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ryan et al. Examiner: Rodriguez, J.
Serial No.: 09/383,508 Group Art Unit: 3653
Filed: August 26, 1999 Docket No.: AMDA.389DIV1
Title: RETICLE SORTER

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence and the papers, as described hereinabove, are being deposited in the United States Postal Service in triplicate, as first class mail, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on September 25, 2002.

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By:

Kelly Waltigney

APPEAL BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

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This is an Appeal Brief submitted pursuant to 37 CFR §1.192 for the above-referenced patent application and is being filed in triplicate.

I. Real Party in Interest

The real party in interest is Advanced Micro Devices, Inc. (AMD), of Sunnyvale, CA. The above-referenced patent application is assigned to AMD.

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. Status of Claims

Claims 1-4, 6-12 and 19 are being formally appealed. The pending claims in their presently-amended form may be found in the Appendix.

IV. Status of Amendments

On November 20, 2000 a first Office Action was mailed and in reply, an Amendment was filed on February 20, 2001. A final Office Action was then mailed on March 22, 2001 followed by an After Final Response filed on May 30, 2001. An Advisory Action was

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mailed on June 11, 2001 and, in response, a Notice of Appeal was filed on June 22, 2001, and an Appeal Brief was filed on August 22, 2001. In response to the Appeal Brief, prosecution was reopened and an Office Action was mailed on September 11, 2001, to which an Office Action Response and Amendment was filed on December 11, 2001. A Final Office Action was mailed on April 26, 2002, and a response thereto was filed on June 26, 2002. A second Advisory Action was mailed on July 23, 2002 and, in response, a Notice of Appeal was filed on July 26, 2002.

V. Summary of Invention

Appellant's invention is directed to a reticle sorter coupled between a reticle storing system 210 and one or more photolithography exposure tools 220. The sorter includes one or more docking locations (*e.g.*, bays) 310 that are adapted for holding a cassette 320 having slots for reticles 324. The sorter also includes a sorting system, which has been adapted for retrieving the reticles from and inserting the reticles into the slots in order to sort the reticles within the cassette (FIGs. 3A and 3B; page 5, lines 25-30). In one implementation, the sorting system also includes a docking location 350. In another embodiment, one or more bays are adapted for holding a plurality of cassettes and a sorting arrangement adapted for sorting the reticles between cassettes (page 5, lines 8-12).

VI. Issues for Review

The claims 1-4, 6-12 and 19 on appeal stand rejected under §112, first and second paragraphs for lack of enablement and definiteness.

The issues are as follows:

Issue 1: Is the §112(2) rejection proper when the Examiner used the wrong test in asserting the rejection?

Issue 2: Is the §112(1) rejection proper when the Examiner used the wrong test in asserting the rejection?

Issue 3: Is the §112(2) rejection proper when the phrases to which the Examiner refers as confusing because they define the same feature are actually directed to different limitations, and when the claimed limitations reasonably apprise those of skill in the art of its scope?

Issue 4: Is the §112(1) rejection proper when the Specification provides sufficient description to enable one skilled in the art to understand how the reticle sorter has one or more bays and how the sorting system, which is part of the reticle sorter, has two or more docking stations?

VII. Grouping of Claims

The claims as now presented do not stand and fall together and are separately patentable for the reasons discussed in the Argument. For purposes of this appeal, the claims should be grouped as follows: group I - claims 1, 3-4, 6-7, 9, 12 and 19; group II – claim 2; group III – claim 8; and group IV - claims 10-11.

VIII. Argument

Appellants submit that the claims of groups I – IV are patentably distinguishable from each other and from the cited prior art references. The claims in group I are patentable over the prior art, as acknowledged by the Examiner, because they include subject matter that is not taught or suggested by any of the references cited. The claim of group II is separately patentable over the other claim groups because it is directed to subject matter that includes a controller for controlling the sorting of the reticles in response to a command from a host system, which is not necessarily present in the other claim groups or the cited prior art. The claim of group III is separately patentable over the other claim groups because it is directed to subject matter that includes an inspection system having a tool adapted for detecting flaws in a reticle pattern, which is not necessarily present in the other claim groups or the cited prior art. The claims in group IV is separately patentable over the other claim groups because it is directed to subject matter that includes a reticle sorter having a sorting system with two or more docking stations, which is not necessarily present in the other claim groups or the cited prior art.

Issue 1: The §112(2) rejection is improper because the Examiner used the wrong test in asserting the rejection.

The Section 112(2) rejection must be reversed because the Examiner used the wrong test as rationale in support of the rejection. Specifically, the Examiner improperly asserted

that the scope of the claims is unclear under Section 112(2) because the claim language is inconsistent with the specification. The correct test under 35 U.S.C. §112(2), however, is not whether the claim language is inconsistent with the specification, but rather whether the “claim reasonably apprises those of skill in the art of its scope.” *In re Warmerdam*, 33 F.3d 1354 (Fed. Cir. 1994) (quoting *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*). As the Examiner acknowledged in the Advisory Action, the specification and claims need not be exactly similar. Similarly, as expressed in the MPEP, it is a long-standing tenet of patent law that word for word support in the specification is not required for satisfying §112(2). Accordingly, the Examiner’s argument in support of the §112(2) rejection is misplaced because it applies the wrong test and because the rationale in support thereof contradicts the law under §112(2). Therefore, regarding all of the claim groups, the Section 112(2) rejection is improper and should be reversed.

Issue 2: The §112(1) rejection is improper because the Examiner used the wrong test in asserting the rejection.

The Section 112(1) rejection should be reversed because it is based on an incorrect test. Specifically, in the Final Office Action, the Examiner asserted that claims 1-4, 6-12 and 19 are rejected under Section 112(1) because “the disclosure is not enabling as it is not commensurate in scope with the claim language.” However, the correct test for enablement under 35 U.S.C. §112(1) is not whether the claim language is inconsistent with the specification, but rather whether the specification teaches those skilled in the art how to make the claimed invention without undue experimentation. *See, e.g., In re Ziegler*, 992 F.2d 1197 (Fed. Cir. 1993). As explained by the Federal Circuit in this decision, *In re Ziegler*, “Nothing more than objective enablement is required, and therefore it is irrelevant whether this teaching is provided through broad terminology or illustrative examples.” As further acknowledged by the Examiner in the Advisory Action, the specification and claims need not be exactly similar. In this regard, Appellant submits that the requirements for satisfying §112(1) have been met because the specification teaches those skilled in the art how to make the claimed invention without any experimentation, as discussed further in connection with Issue 4 below, and because the Office Action has not alleged otherwise. Therefore, regarding all of the claim groups, the Section 112(1) rejection must be reversed.

Issue 3: The §112(2) rejection is improper because the phrases to which the Examiner refers are directed to different limitations and, therefore, do not “define the same feature with two different names,” as the Examiner asserts; accordingly, the claimed limitations reasonably apprise those of skill in the art of its scope.

The Section 112(2) rejection should further be reversed because the assertedly confusing limitations define different claim limitations, rather than the same feature. As discussed above and as apparently acknowledged by the Examiner in the Advisory Action, the correct test under Section 112(2), is whether the “claim reasonably apprises those of skill in the art of its scope.” *In re Warmerdam*, 33 F.3d 1354 (Fed. Cir. 1994) (quoting *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*). In this instance, the Examiner improperly asserted in the second Advisory Action that the limitations “bays” and “docking locations” are confusing because they “define the same feature with two different names.” Appellant submits that this assertion is improper because the limitations are directed to two different features. Carefully reviewing claim 1 of group I, limitations are directed to a reticle sorter having one or more bays and a sorting system. Claims 10 and 11 in group IV, which depend from claim 1, are directed to the “reticle sorter of claim 1, wherein the *sorting system* includes two or more docking locations.” Appellant submits that it is clear that the limitation “reticle sorter” of claims 10 and 11 would have “one or more bays” as well as a “sorting system,” wherein the sorting system has “two or more docking locations.” In this regard, it is clear that the bays of the reticle sorter are separate from the docking locations of the sorting system, which are within the reticle sorter.

Moreover, contrary to the Examiner’s position in the Advisory Action, the terms “bay” and “docking location” would not be confusing, if interchangeable, because the claimed reticle sorter is capable of having two similar limitations for different portions thereof. These limitations are supported with discussion of example embodiments in the Specification, for example, on page 5, line 18 through page 6, line 12, with docking locations discussed in connection with both the reticle sorter and the sorting system. Specifically, page 5, lines 24-26 discuss docking locations “capable of holding a cassette.” As similarly discussed on page 2, lines 24-25 of the Specification, an example reticle sorter is discussed having “one or more bays capable of holding a cassette.” Therefore, the limitations “bays”

and “docking location” are thus similarly described as essentially being a place where cassettes can be stored.

In view of the above, using the proper test for establishing a Section 112(2) rejection, the claimed limitations clearly would apprise one of skill in the art of its scope. Therefore, the Section 112(2) rejection must be reversed.

Issue 4: **The §112(1) rejection is improper because the Specification provides sufficient description to enable one skilled in the art to understand how the reticle sorter has one or more bays and how the sorting system, which is part of the reticle sorter, has two or more docking stations.**

The section 112(1) rejection is improper and should be reversed for the reasons stated above in connection with Issue 3 and the impropriety of the Section 112(1) rejection, regarding the description of the limitations “bays” and “docking locations.” As discussed above, the correct test for enablement under 35 U.S.C. §112(1) is whether the specification teaches those skilled in the art how to make the claimed invention without undue experimentation. *See, e.g., In re Ziegler, 992 F.2d 1197* (Fed. Cir. 1993). In this instance, the specification teaches those skilled in the art how to make the claimed invention without any experimentation, and the Examiner has not alleged otherwise. For example, page 2, line 22 through page 3, line 2; and page 3, line 26 through page 4, line 19 discuss “bays” in a manner that would clearly enable one skilled in the art to make the claimed invention. In this regard, the Examiner’s assertion in the Final Office Action that the specification lacks proper description for the “bay” feature of claims 1 and 19 in group I is unsupported and contrary to the plain language in the specification. Therefore, Appellant submits that the independent claims 1 and 19 in group I comply with §112(1). Because claims 2-4 and 6-12 (in groups I-IV) depend directly or indirectly on independent claim 1, include the features recited in the independent claim on which they depend, as well as additional features, Appellant submits that claims 2-4 and 6-12 also comply with §112(1). Therefore, the Section 112(1) rejection must be reversed.

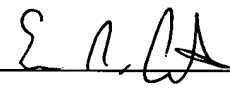
IX. Conclusion

In view of the above, Appellant believes the claimed invention to be patentable. Claims 1-4, 6-12 and 19 remain for consideration. Appellant respectfully requests reversal of the rejection as applied to the appealed claims and allowance of the entire application.

Please charge Deposit Account No. 01-0365 (TT2354DIV) in the amount of \$320.00 for filing a Brief in support of an appeal as set forth in §1.17(c).

Respectfully submitted,

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APPENDIX OF APPEALED CLAIMS (09/383,508)

1. A reticle sorter coupled between a reticle storing system and one or more photolithography exposure tools, comprising:
 - one or more bays adapted for holding a cassette having slots for reticles;
 - a sorting system adapted for retrieving the reticles from and inserting the reticles into the slots in order to sort the reticles within the cassette; and
 - an inspection system, coupled between the one or more bays and an input port of the reticle sorter, for inspecting a characteristic of each reticle.
2. The reticle sorter of claim 1, further including a controller coupled to the sorting system for controlling the sorting of the reticles in response to a command from a host system.
3. The reticle sorter of claim 1, further including a storage location for holding a reticle, wherein the sorting system may place a selected reticle on the storage location during a sorting operation.
4. The reticle sorter of claim 1, wherein the sorting system includes an arm with claws for grasping edges of reticles.
6. The reticle sorter of claim 1, wherein the inspection system includes a video camera coupled to a display device for presenting a visual image of a reticle.
7. The reticle sorter of claim 1, wherein the inspection system includes a tool for measuring an amount of dust on a reticle.
8. The reticle sorter of claim 1, wherein the inspection system includes a tool adapted for detecting flaws in a reticle pattern.

9. The reticle sorter of claim 1, further including means for moving each of the cassettes from the input port to one of the one or more bays.

10. The reticle sorter of claim 1, wherein the sorting system includes two or more docking locations.

11. The reticle sorter of claim 10, wherein the sorting system is adapted to move reticles between a first cassette in a first one of the two or more docking locations and a second cassette in a second one of the two or more docking locations.

12. The reticle sorter of claim 1, including three or more bays.

19. A reticle sorter coupled between a reticle storing system and one or more photolithography exposure tools, comprising:

one or more bays adapted for holding a plurality of cassettes having slots for reticles;

and

a sorting arrangement adapted for retrieving the reticles from and inserting the reticles into the slots so as to sort the reticles between cassettes.